



UNITED STATES DEPARTMENT OF COMMERCE
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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/196,812 02/02/94 NILSSEN

B5M1/0428

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EXAMINER

MIS, D

ART UNIT

PAPER NUMBER

2502

DATE MAILED:

04/28/94

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 2/2/94 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 0 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-46 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. ☐ Claims _____ have been cancelled.

3. ☐ Claims _____ are allowed.

4. ☒ Claims 1-46 are rejected.

5. ☐ Claims _____ are objected to.

6. ☐ Claims _____ are subject to restriction or election requirement.

7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).

12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

EXAMINER'S ACTION

Art Unit: 2502

1. In claim 1, lines 18-27, the inverter circuit is characterized. If an AC voltage of inverter frequency happens to exist across the ground and one rectifier output terminal then it must have a negligible magnitude compared to the inverter AC voltage - for some reason. Why? Where in the specification is this phenomena described? Is it an advantage provided by the present circuit? If it is provided by certain features of the present circuit, what are the features? Also, if an AC voltage of "high-frequency AC voltage" frequency exists across the DC terminals ("the high-frequency AC voltage" has no antecedence, and "existing" should probably be --exists--.) then it is of very low magnitude compared to the inverter AC voltage - also for some reason. Why, etc. ... (same questions). Answers to the foregoing questions will provide information as to whether or not each of the respective elements of the present circuit can or can not be construed to cover the claimed phenomena. It is necessary to know why to construe that at least some means of the present circuit cover the claimed functions since the sixth paragraph of 35 USC 112 allows construing when it is known what means cover a function. The specification should say what the functions of the circuit are and what the functions of parts of the circuits are as appropriate to enable use of functional language in the claims.

Art Unit: 2502

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 C.F.R. § 1.75(d)(1) and M.P.E.P. § 608.01(1). Correction of the following is required: (See the above noted requirements of the specification.).

It is assumed that one of ordinary skill in the art would understand how the circuit performed the functions of the claims, however, the specification must say that the circuit performs the claimed functions.

Nevertheless, some additional indication of the importance of the claimed functions is necessary to make it apparent that novelty is pointed out by them, i.e. all circuits have functions and means performing them but only the novel functions and means are patentable and one important fact about all patentable claims is that they point out a novel feature that has utility. In other words, it is not apparent why the above mentioned circuit phenomena are believed to possess a novel nature.

3. Only the above discussion is provided with respect to one claim. Discussion of the other claims is represented by the above basic discussion since the other claims possess similar language. The corresponding objections for the other claims should be apparent.

Art Unit: 2502

4. Claims 1-46 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, specific defects are mentioned above. For all of the claims it is not clear where the claim language is explained in the specification and it is therefore not apparent how to construe what is claimed and so the claims do not particularly point out what is claimed.

5. Allowing claims is not objected to, so if there is novelty to be pointed out then any amendment should be directed to doing so by explaining in the specification what does the claimed functions and why the claimed functions provide utility.

6. 35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

The key word is "useful".

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Mis whose telephone number is (703) 308-4907.


DAVID MIS
EXAMINER
GROUP ART UNIT 252

dm
April 26, 1994